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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,244	01/29/2001	Rajkishore Barik	JP920000376US1	9198

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McGinn & Gibb PLLC
Suite 304 2568 A Riva Road
Annapolis, MD 21401

EXAMINER
CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
03/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/772,244	BARIK ET AL.
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 December 2008</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *See Continuation Sheet* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4,5,7,15,16,18,19,22-31,33-35,49-57,59-62,64,66,67,69 and 70.

Continuation of Disposition of Claims: Claims rejected in the application are 1,2,4,5,7,15,16,18,19,22-31,33-35,49-57,59-62,64,66,67,69 and 70   .

DETAILED ACTION

This action is responsive to the paper(s) filed 12/10/2008.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   **Claims 1-2, 4-5, 7, 15-16, 18-19, 21-31, 33, 35, 49-57, 59, 61, 62, 66 are**

rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski

(US6932270).

3.   Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and

methods for storing electronic coupons, associating them with customers, presenting

them at a retail POS and redeeming them. A user is provided with a card which

provides a userID [4:6-81]. The card is used to associate selected coupons from a

plurality of available coupons from different sources (by scanning paper coupons, by

selecting coupons at a kiosk or by downloading coupons from the Internet) with the

user's account in a database [3:63-65, 6:I-5,6:22-251. When the card is presented at the

POS along with scanned products to be purchased (i.e. before the purchase is

completed by way of accepting payment - and therefore, "before purchase"), the POS

system determines what coupons of the user's collection of selected coupons are

redeemable given the user's scanned products; the system displays these coupons on

the display [16:18-31, 17:31-33,4:25-35]. Fajkowski teaches that the coupon eligibility

parameters (product name, required size, quantity or combination of items required,

expiration) may be stored on the card in order to determine applicable coupons at the

POS against the parameter requirements [10:17-26]. Applicant admits that mutual

exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-

22] and that certain coupons also may provide benefits of monetary discount, loyalty

points and freebies [spec pg 2 lines 14-19]. It would have been obvious for one of

ordinary skill in the art at the time of the invention to have stored and analyzed other

well known coupon restriction rules such as whether other coupons can be used in

combination with a coupon. Doing so would enable the system to process and

accurately display a wide variety of eligible coupons, including those with exclusivity

rules and those without. Examiner will now address the limitations associated with

checking if eligible coupons also meet optimization parameters. Applicant has admitted

that customers frequently have a collection of eligible coupons from which to choose,

leaving the consumer with the task of determining which subset of eligible coupons will

provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum

freebies). It has been done manually, but it is admittedly difficult in certain situations

[spec pg 2 lines 11 -19]. Historically, checkout clerks inherently were required to

possess the ability to determine coupon eligibility, else fraudulent coupon redemption

would be possible. One of ordinary skill would consider it to be a matter of good

customer service for a checkout clerk to assist a customer regarding which coupons

could be used (i.e. eligibility) as well which subset of coupons would most benefit the

customer for example helping a customer who asks "which coupon(s) would' save the

most money?" and/or "which of these coupons should I use quickly before they expire"

There should be no doubt that consumers frequently use coupons in order to get the

best savings. It would have been obvious to one of ordinary skill at the time of the

invention to have provided assistance to customers faced with navigating the

recognized (albeit in some cases difficult or confusing) coupon rules and options

imposed by the retailer. Fajkowski's system accomplishes the automated eligibility

determination in the manner of an Expert System (a computer system programmed to

replace a human clerk having the knowledge to determine eligibility for the universe of

participating coupons and their restrictions/parameters). Fajkowski's system is also

quite intelligent in that it can recommend an additional purchase when a consumer

possesses a valuable coupon, but has not fully met the purchasing qualifications

(perhaps the user chose the wrong size product) [19:38-43]. This is another example of

an Expert System capability. Fajkowski's system has been argued to lack presentation

to the consumer of a subset of all eligible coupons according to price optimization, yet it

would have been obvious to one of ordinary skill at the time of the invention to have

provided this desired but heretofore manual capability in an automated manner. See

Automating a manual activity -MPEP 2144.04(111). In re Venner, 262 F.2d 91, 95, 120

USPQ 193, 194 (CCPA 1958).   In the same manner as outlined in rationale F of KSR, it

would have been obvious to one of ordinary skill at the time of the invention to have

updated the known invention of Fajkowski with modern automated improvements in

order to gain the commonly understood benefits of such adaptation. All this would be

accomplished with no unpredictable results.

As stated in **Leapfrog,** "applying modern electronics to older mechanical devices has
been commonplace in recent years." **Leapfrog Enterprises, Inc. v. Fisher-Price, 485
F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007).**

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed

which are not fully eligible along with the reasoning for their near-eligible status, such as

the product is the wrong size [I9:38-43]. It would have been obvious for one of ordinary

skill in the art at the time of the invention to have displayed a similar message when a

user has not presented the proper quantity or combination of products [these

parameters are disclosed at 10:22-23] when possessing a coupon with such size or

quantity restrictions. Both of these examples are taken to provide a teaching of

recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at

least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken

to reside at the retailer site.

Regarding claim 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons

specific to products presented is taken to provide a step of computing a set of coupons

dependant upon a user's set of coupons as well as upon the order information. The step

of determining if the computed coupon set complies with redeeming conditions is met by

inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does

not comply with redemption criteria, the customer is free to return another time with a

another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons

are shown at the POS, the customer may wish to investigate why some coupons were

non-complaint [I9:21-25]. The POS may be used to display all coupons that were non-

compliant [19:44-53]; it would have been obvious for one of ordinary skill in the art at

the time of the invention to have displayed non-compliant coupons for any non-

compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 55, 56, Fajkowski teaches that the user may save

shopping lists with specified coupons for the products on the list to be used on future

shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon

item the user wishes to purchase, but where the item is currently unavailable. The

system will save such a list of rain-checked product(s) for later use. In either case,

future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports

of coupon usage and savings [I 3:5-7, 17:48-63]. User acceptance for redemption of

the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition

for a coupon having plural redemption conditions (expiration date and product size, for

example).

Claims 34, 60, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Beach et al (US200210107738).

Regarding claims 34, 60, 64, Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Claims 1-2, 4-5, 7, 15-16, 18-19, 21-31, 33, 35, 49-57, 59, 61, 62, 66 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270) in view of Marmon (1184446528).

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a ,userID [4:6-81. The card is used to associate selected coupons from a plurality of available coupons from 'different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5, 6:22-251. When the card is presented at the POS along with products to be purchased, the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's

potential purchases; the system displays these coupons on the display [I6:18-31, 17:31-33,4:25-351. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS [I 0:17-261. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules. Examiner will now address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11-19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-601. Marmon notes

that the consumer is confronted with many price-affecting choices related to coupons

and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of

optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit

pricing techniques [col 3 lines 20-221. The calculations done by the system of Fajkowski

consider the impact of the coupon and the optimum choice, i.e. lowest until price is

indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the

automated eligibility determination and it would have been obvious to one of ordinary

skill at the time of the invention to have also provided automated coupon optimization

assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price

given the subset of eligible coupons possessed) to customers faced with navigating the

coupon rules and options imposed by the retailer. This would .enable the customer to

most benefit from his coupons, deliver the lowest prices as is generally desired as well

as encourage purchasing of retailer products.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed

which are not fully eligible along with the reasoning for their near-eligible status, such as

the product is the wrong size [19:38-431. It would have been obvious for one of ordinary

skill in the art at the time of the invention to have displayed a similar message when a

user has not presented the proper quantity or combination of products [these

parameters are disclosed at 10:22-231 when possessing a coupon with such size or

quantity restrictions. Both of these examples are taken to provide a teaching of

recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claims 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [19:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 55, 56, Fajkowski teaches that the user may . save shopping lists with specified coupons for the products on the list to be used on future shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The

system will save such a list of rain-checked product(s) for later use. In either case,

future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports

of coupon usage and savings [13:5-7, 17:48-631. User acceptance for redemption of

the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition

for a coupon having plural redemption conditions (expiration date and product size, for

example).

Claims 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being

unpatentable over Fajkowski in view of Beach et al (US200210107738).

Regarding claims 34, 60, 64, Beach et al also teaches user collection of e-

coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons

can be recommended to the user based on his user profile [para. 35 (middle of page)]. It

would have been obvious for one of ordinary skill in the art at the time of the invention to

have suggested coupons for the user based on his profile so that the user can be

conveniently targeted with offers that are likely to be accepted and purchased. These

recommendations are taken to be optimal or near optimal recommendations.

4.   Claims 1-2, 4-5, 7, 15-16, 18-19, 21-31, 33, 35, 49-57, 59, 61, 62, 66 are

alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over

Fajkowski (US6932270) in view of Wilkman (US20020013728).

5.   Wilkman 2002/0013728 enjoys benefit of earlier provisional 60/220637 filed

7/25/2000. Examiner will be referring throughout this office action to the page and line

number of 60/220637 as evidence of previous support even though the rejection is

being made using the 2002/0013728 reference.

6.   Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and

methods for storing electronic coupons, associating them with customers, presenting

them at a retail POS and redeeming them. A user is provided with a card which

provides a userID [4:6-8]. The card is used to associate selected coupons from a

plurality of available coupons from different sources (by scanning paper coupons, by

selecting coupons at a kiosk or by downloading coupons from the Internet) with the

user's account in a database [3:63-65, 6:I-5,6:22-25]. When the card is presented at the

POS along with scanned products to be purchased (i.e. before the purchase is

completed by way of accepting payment - and therefore, "before purchase"), the POS

system determines what coupons of the user's collection of selected coupons are

redeemable given the user's scanned products; the system displays these coupons on

the display [16:18-31, 17:31-33,4:25-35]. Fajkowski teaches that the coupon eligibility

parameters (product name, required size, quantity or combination of items required,

expiration) may be stored on the card in order to determine applicable coupons at the

POS [10:17-26]. Applicant admits that mutual exclusivity is a restrictive, eligibility

coupon parameter often used [spec page 1 lines 21-22] and that certain coupons also

may provide benefits of monetary discount, loyalty points and freebies [spec pg 2 lines

14-19]. It would have been obvious for one of ordinary skill in the art at the time of the

invention to have stored and analyzed other well known coupon restriction rules such as

whether other coupons can be used in combination with a coupon. Doing so would

enable the system to process and accurately display a wide variety of eligible coupons,

including those with exclusivity rules. Examiner will now address the limitations

associated with checking if eligible coupons also meet optimization parameters.

Applicant has admitted that customers frequently have a collection of eligible coupons

from which to choose, leaving the consumer with the task of determining which subset

of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum

loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult

('non trivial' in certain situations [spec pg 2 lines 11 -19]. Historically checkout clerks

inherently were required to possess the ability to determine coupon eligibility, else

fraudulent coupon redemption would be possible. One of ordinary skill would consider it

to be a matter of good customer service for a checkout clerk to assist a customer

regarding which coupons could be used (i.e. eligibility) as well which subset of coupons

would most benefit the customer for example helping a customer who asks "which

coupon(s) would' save the most money?" and/or "which of these coupons should I use

quickly before they expire" Fajkowski's system is also not without automation and is

quite intelligent in that it can recommend an additional purchase when a consumer

possesses a valuable coupon, but has not fully met the purchasing qualifications

(perhaps the user chose the wrong size product) [19:38-43]. Wilkman also recognizes

the variety of incentive offers available to purchasing consumers and he teaches the

use of a computer-based optimization routine that takes the legwork out of manually

analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have provided systems and methods that provide assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the incentive providers. Rather than take the time and energy to manually track all of the provided options, restrictions and benefits, it would have been obvious to one of ordinary skill at the time of the invention to have provided a computer system to optimize the 'non trivial' combination of coupon restrictions and benefits, so that the consumer need not be burdened with the research (although it is well accepted that in the past the research has been capably done manually).

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [l9:38-43]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-23] when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claim 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [I9:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 55, 56, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [l 3:5-7, 17:48-631. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Claims 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski and Wilkman as above and further in view of Beach et al (US200210107738).

Regarding claims 34, 60, 64, Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Claims 1-2, 4-5, 7, 15-16, 18-19, 21-31, 33, 35, 49-57, 59, 61, 62, 66 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski and Wilkman as above and further in view of Marmon (1184446528).

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-601. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-221. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer. This would .enable the customer to most benefit from his coupons, deliver the lowest prices as is generally desired as well as encourage purchasing of retailer products.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-431. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a

user has not presented the proper quantity or combination of products [these

parameters are disclosed at 10:22-231 when possessing a coupon with such size or

quantity restrictions. Both of these examples are taken to provide a teaching of

recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at

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another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons

are shown at the POS, the customer may wish to investigate why some coupons were

non-complaint [19:21-251. The POS may be used to display all coupons that were non-

compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at

the time of the invention to have displayed non-compliant coupons for any non-

compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 55, 56, Fajkowski teaches that the user may . save

shopping lists with specified coupons for the products on the list to be used on future

shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon

item the user wishes to purchase, but where the item is currently unavailable. The

system will save such a list of rain-checked product(s) for later use. In either case,

future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports

of coupon usage and savings [13:5-7, 17:48-63]. User acceptance for redemption of

the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition

for a coupon having plural redemption conditions (expiration date and product size, for

example).

Claims 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being

unpatentable over Fajkowski and Wilkman as above and further in view of Beach

et al (US200210107738).

Beach et al also teaches user collection of e-coupons which are redeemed at the

POS [para. 13]. Beach et al teaches that coupons can be recommended to the user

based on his user profile [para. 35 (middle of page)]. It would have been obvious for one

of ordinary skill in the art at the time of the invention to have suggested coupons for the

user based on his profile so that the user can be conveniently targeted with offers that

are likely to be accepted and purchased. These recommendations are taken to be

optimal or near optimal recommendations.

Response to Arguments

Applicant has added some language that clarifies that the invention determines

mutually exclusive coupons as well as non-mutually exclusive coupons and can

optimize coupon selection by selecting a combination of non-mutually exclusive

coupons. Applicant also argues that the claim amendments do not change the scope of

the claims. As the examiner has previously made his case why it would have been

obvious to one of ordinary skill at the time of the invention to have automated the

suggestion of an optimized combination of coupons and as only non-mutually exclusive

coupons can inherently be used in combination, the previous rejection still addresses

the current claim set.

Applicant argues that Fajkowski only checks coupons after purchase. This is

entirely incorrect. Like applicant, Fajkowski scans products to determine *products*

under consideration for purchase, so that the scanned products (not yet purchased) can

be compared to the coupons offered for redemption during the purchase. The coupons

are certainly not redeemed by the cash register after the purchase is finalized, but

before – so that the consumer can reduce *his purchase price*. Fajkowski uses the term

purchase data and items purchased to refer to items scanned, but not paid for (i.e. not

purchased; i.e. "before purchase"). Applicant points to the top of column 17 of

Fajkowski and fig 15a, yet if applicant would consider the bottom of Column 17 and

companion figure 15b, he would see that Fajkowski scans products, considers coupons

for redemption, then finalized the current purchase.

Applicant argues that because Fajkowski appears to teach certain coupons

applicable to the same product but which may not be redeemed together, that Fajkowski

teaches away from coupons that can be used together. This is untrue. At best

Fajkowski is silent on coupons that may be used together (examiner believes this to be

called "stacking coupons"). Applicant admits these types of combinable coupons are

well known and as stated in the rejection, it would have been obvious to one of ordinary

skill at the time of the invention to have enabled the system of Fajkowski to properly

treat such coupons. Applicant's only argument why this is a teaching away is that

Fajkowski is concerned with fraudulent redemption. Of course, Fajkowski prevents

stacking coupons when the coupon rules prohibit. However one of ordinary skill would

actually find it entirely consistent with Fajkowski's intention of "following the coupons'

redemption rules" when stackable coupons are present.

Applicant argues that the claimed system is a very complicated decision-making

system and which "might not be able to be performed manually" and performs steps

"that could not be performed manually". Examiner will ignore the "might not" argument

as it seems to agree with examiner because it also inherently asserts that indeed the

decision "might be" capable of being performed manually. When applicant argues the

steps "could not be performed" manually, there is no reasoning given other that it can

be difficult ("or non-trivial" pg 1 line 21). It is first pointed out that at least some of

applicant's claims do not require any automation and therefore they actually read on a

manual process. Applicant's claims are not limited in any way to any particular difficult

scenarios or decision making – they include the claim scope where the potential

combinations of coupons and their resulting benefits are actually rather straightforward.

Nonetheless, applicant's system is taken to be programmed essentially by creating a

systemic approach to evaluating the coupon redemption combinations. These

evaluations can be done manually – and in fact have been done for years by both

consumers and POS clerks or POS systems charged with preventing fraudulent

redemption as recognized by applicant. Prior to applicant's invention, the coupon

combination possibilities (collection of coupon rules) were already 'difficult' at times.

And at these times, either the consumer or the clerk would **have** to understand the

"difficult" rules in order to properly redeem coupons. Applicant is merely automating

what has been required previously. Applicant has not created a more challenging

coupon redemption situation requiring automation to resolve redemption rules, he

merely is now choosing to turn to computer automation to resolve old situations -

situations that would have been manually resolved without the invention. Further,

consider a customer with poor eyesight or poor reading skills or less-than-common

math skills. Any helpful merchant or sales clerk would find it obvious help them

"navigate" the applicable coupon rules so they can benefit most (discount, loyalty,

freebies) – that is simply good customer service.

Applicant argues that the art does not teach a user defining optimization

parameters and display of eligible coupons satisfying the criteria. The rejection above

addresses the concept that one of ordinary skill would find it obvious that rather than

choose the best coupons manually (as admitted has happened in the past), to automate

the recognized difficult, and/or time consuming tasks of choosing the best coupon for

that user's desires. One of ordinary skill would see that a computer programmed with

the coupon rules/restrictions would be a predictably faster, more convenient, and more

accurate way to navigate the same steps historically done manually. Further, *KSR*

forecloses the argument that a specific teaching is required for a finding of obviousness

(citing *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). See Board decision *Ex parte*

Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

7.   It was well known at the time of the invention that merely providing an automatic

means to replace a manual activity which accomplishes the same result is not sufficient

to distinguish over the prior art, *In re Venner,* 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958). In the same manner as outlined in rationale F of KSR, it would have

been obvious to one of ordinary skill at the time of the invention to have updated the

known invention of Fajkowski with modern automated improvements in order to gain the

commonly understood benefits of such adaptation. All this would be accomplished with

no unpredictable results.

As stated in **Leapfrog,** "applying modern electronics to older mechanical devices has
been commonplace in recent years." **Leapfrog Enterprises, Inc. v. Fisher-Price, 485
F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007).**

        For example, simply automating the steps of coupon selection gives just what

one would expect from the otherwise manual steps. In other words, there is no

enhancement found in the claimed steps/system other than the known advantage of

increased speed, increased accuracy, increased convenience and reduction in human

resource(s) to perform/provide the claimed steps/functionality. The end result is the same as compared to the manual method.

Applicant argues that that Marmon teaches a calculation whether it is better (i.e. optimal) whether to use a coupon or not. Applicant then states that therefore Marmon is "unrelated" to the claimed system. Examiner disagrees and it is rather clear that Marmon is actually *closely related* with coupon decision making and suggesting coupon usage that would be optimum for the user.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/   Jeffrey D. Carlson
Primary Examiner, Art Unit 3622   Primary Examiner
                                                           Art Unit 3622

jdc